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EXAMINER

NASH, LASHANYA RENEE

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,649

Applicant(s)

YABE, HIROSHIYE

Examiner

LaShanya R. Nash

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

This action is in response to an Amendment filed January 4, 2005. Claims 1-15 are presented for further consideration.

Response to Arguments

Objections made to the specification, see Remarks *Specification Objection*, have been withdrawn.

Claim objection, see Remarks *Claim Objections*, with respect to claim 1 has been withdrawn.

Claim rejections, see Remarks *Rejection under 35 USC 112*, with respect to claims 1, 5-8, and 4 have been withdrawn.

Applicant's arguments, see Remarks/Arguments *103 Rejection of the Claims*, with respect to claims 1-3, and 14 rejected under 35 USC 102(e), have been fully considered but are moot in view of the new ground of rejection under 35 USC 103(a), as set forth below in the office action.

Applicant's arguments, see Remarks/Arguments *103 Rejection of the Claims*, with respect to claims 4-13, and 15 are rejected under 35 USC 103(a), have been fully

considered but are moot in view of the new ground of rejection under 35 USC 103(a), as set forth below in the office action.

In considering the Applicant's arguments the following remarks are noted:

(I) Presto-print.com reference is out of the field of endeavor and is not an analogous art.

In considering (I), Applicant contends that Examiner cited reference (i.e. Presto-print.com) is out of the field of endeavor and is not an analogous art. Examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, presto-print.com is directly related to employing a telecommunications network (i.e. via Internet site, <http://www.presto-print.com>), in order to deliver a personalized message (i.e. acrostic poetry) to a recipient. Telecommunication messaging is pertinent to the Applicant's filed of endeavor, thereby making the aforementioned Presto-print.com an analogous art. Therefore, Examiner maintains that it would have been obvious to combine Presto-print.com (i.e. message containing recipient's name in acrostic poetry form) with cited references (as set forth below in the office action), because including a recipient's name to a graphic image for personalizing a message delivered via a network was well known

in the art at the time of the invention (Hayes-Roth; e.g. **Rick**; paragraph [0024], line 5 to paragraph [0025], line 25; Figures 1,3,5).

Claim Objections

Claims 10-12 are objected to because of the following informalities: inconsistent terminology.

Claims 10-12 recite the limitation "the temporary name", in lines 2 of the aforementioned claims. Examiner suggests replacing with "the tentative character's name", for consistent terminology.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur (US Patent 6,212,550) in view of Hayes-Roth (US Patent Application Publication 2002/0054072 and US Patent 6,031, 549 incorporated by reference), herein after referred to as Segur and Hayes-Roth respectively.

In reference to claim 1, Segur discloses a system for delivering stored messages in a plurality of communication formats to a specified recipient, in order reduce the

number of potential messaging sources (column 1, lines 58-65; column 4, lines 10-15; and Figure 2). Segur discloses:

- An individually delivering system in which a terminal (i.e. message receiving device) of each recipient is connected to a host computer (i.e. client-server) via a wireless or wired telecommunications network, (column 2, lines 10-45; column 2, lines 53-55; and Figure 2);
- A recipient identifying device (i.e. client-server) for relating a request (i.e. message) from the terminal with a specific recipient by the recipient's information including the recipient's address (i.e. email address) and name pre-stored (i.e. customer id), (column 3, lines 2-23; column 2, lines 56-60; and Figure 4);
- A name exchanging device (i.e. client-server) adapted to exchange the recipient's name for a temporary name (i.e. one of a plurality of addresses) accompanying text or graphic matter previously stored in a recorder (i.e. memory), (column 3, lines 5-17 and Figure 5); and
- A delivery device (i.e. client-server) adapted for individually delivering the text or the graphic matter into which the recipient's name has been introduced by the name exchanging device to the recipient's mail address at a time or times predetermined by the recipient identifying device, (column 3, lines 27-34; column 3, line 52-65; column 4, lines 3-9; column 2, lines 6-8; and Figure 6).

Although the reference shows substantial features of the claimed invention, the reference fails to show a recording device, paragraphs with a tentative character's name, or graphic images composed of a tentative characters name are stored in the

recoding device; and a name exchanging device the tentative character's name in the paragraphs or graphic images is replaced by the recipients name by the name exchanging device. However, this would have been an obvious modification to the aforementioned system disclosed by Segur, for one of ordinary skill in the art at the time of invention, as further evidenced by Hayes-Roth.

In another analogous art, Hayes-Roth discloses an interactive messenger system (i.e. Imp Character Development Kit [ICDK]) that employs an animated graphic with paragraphs (i.e. text message) (paragraph [0024], line 5 to paragraph [0025], line 25; Figure 1). This graphic image is further disclosed to compose user-customizable components, so as to exchange a tentative name (e.g. recipient-name; Figure 2; paragraph [0025], line 1 to paragraph [0033], line 1) with a specific recipient name (e.g. Rick; Figure 3 and Figure 5). Hayes-Roth further discloses that the ICDK messaging system employs a recording device ([6,031, 549] i.e. workstation memory; Figure 5-item 12 and Figure 2-item 26), wherein the graphic images ([6,031, 549] i.e. agent applications; column 7, lines 25-49; column 8, lines 54 to column 10, line 15) comprising the tentative name are stored in the recording device ([6,031, 549] i.e. agent application). In addition, exchanging device ([6,031, 549] i.e. animator; Figure 5-item 14) the tentative character's name in the paragraphs or graphic images is replaced by the recipients name by the name-exchanging device, ([6,031, 549] i.e. animates graphic image; column 7, lines 54-61). This modification would have been obvious because one of ordinary skill in the art would have been motivated to make use of interactive agent technology to enable senders to dispatch interactive messengers to initiate or solicit

personalized interactions, thereby increasing system personalization for users (Hayes-Roth paragraph [0008], lines 1-6).

In reference to claim 2, Segur discloses the multi-format messaging system wherein the text delivered by the delivery device (i.e. client-server) to the mail address (i.e. email address) of the recipient comprises voice data, (column 1, line 65 to column 2, line 6 and column 2, lines 62-65).

In reference to claim 3, Segur discloses the multi-format messaging system wherein the text delivered by the delivery device (i.e. client-server) to the mail address (i.e. mail address) of the recipient comprises moving image (i.e. video mail messages), (column 1, line 65 to column 2, line 6).

In reference to claim 8, Hayes-Roth discloses the multi-format messaging system wherein each of the graphic images is composed of the tentative character's name, (e.g. recipient-name; Figure 2; paragraph [0025], line 1 to paragraph [0033], line 1).

In reference to claim 14, Segur discloses the multi-format messaging system wherein the name exchanging device (i.e. client-server) is operatively associated with the recipient identification device so that every paragraph or graphic image can be delivered differently among recipients, (column 3, lines 25-34).

Claims 4,9-10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur and Hayes-Roth, as applied to the claims above, and further in view of Balma et al. (US Patent 6,157,945), herein after referred to as Balma.

In reference to claim 4, Segur and Hayes-Roth disclose substantial features of the claimed invention as previously evidenced, particularly identifying the intended recipient (Segur column 3, lines 27-34). However, the reference fails to disclose the recipient identifying device recording a time at which the recipient's personal data was received together with the personal data and identifies the recipient. Nonetheless, this modification to the aforementioned system would have been obvious to a person of ordinary skill in the art at the time of the invention, as further evidenced by Balma.

In an analogous art, Balma discloses a system for routing or forwarding electronic messages to an intended recipient according to stored personal data (i.e. profile) defined by the recipient. Balma further discloses the user profile contains an associated date/time field for the received personal data (column 7, lines 54-58; column 8, lines 41-49; and Figure 5). This modification would have been obvious to the multi-format message system as disclosed by Segur and Hayes-Roth because one of ordinary skill in the art would have been motivated to extend the functionality of the system for automatic delivery of messages based on temporal information, thereby increasing the ease of use (Balma column 2, lines 1-6).

In reference to claim 9, Balma discloses a multi-format messaging system wherein the recipient's personal data (i.e. profile) includes attributes of this recipient and memorial days (i.e. holidays) peculiar to this recipient, (Balma column 7, line 54 to column 8, line 60; column 9, lines 29-46; Figure 5; and Figure 6-item 304).

In reference to claim 10, Segur and Balma disclose a multi-format messaging system wherein the text accompanied with the temporary name (i.e. address) is a liaison matter for business (i.e. corporate communications), (Segur column 3, lines 27-34; Balma column 7, line 58 to column 8, line 10; and column 2, lines 25-40).

In reference to claim 15, Balma discloses a multi-format messaging system wherein the recipient's personal information (i.e. profile) includes date and hour (i.e. scheduling information) in which paragraphs or the graphic images should be delivered (Balma column 9, lines 29-46; column 9, lines 61-64; and Figure 6-item 304).

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur and Hayes-Roth, as applied to the claims above, and further in view of Balma et al. (US Patent 6,157,945) and Reynolds et al. (US Patent 6,052,717), herein after referred to as Balma and Reynolds respectively.

In reference to claim 5, Segur and Hayes-Roth disclose a multi-format messaging system wherein the text is accompanied with a temporary name (i.e. address), (Segur column 3, lines 27-34). However, the reference fails to disclose the

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aforementioned text is a chapter constructed by paragraphs, and a serial novel is constructed by the chapters, which are successively delivered to the recipient separately. Nonetheless, one of ordinary skill in the art would have readily recognized at the time of the invention the advantages associated with implementing these limitations in the multi-format system, as further evidenced by Balma.

In an analogous art, Balma discloses a system for routing or forwarding electronic messages to an intended recipient according to stored personal data (i.e. profile) defined by the recipient. In addition, Balma discloses routine scheduling for routing communications to a recipient, specifically forwarding on a daily basis (Balma column 9, line 29-46). This modification would have been obvious to the multi-format message system as disclosed by Segur and Hayes-Roth because one of ordinary skill in the art would have been motivated to extend the functionality of the system for automatic delivery of messages based on temporal information, thereby increasing the ease of use (Balma column 2, lines 1-6).

In another analogous art, Reynolds discloses an interactive web book (ibook) system that allows users to view the contents of an interactive book (i.e. novel) that resides on a data network, (i.e. Internet), (column 1, lines 24-38, and column 3, lines 3-16). Reynolds also discloses interactive books to contain several chapters and characters (i.e. paragraphs), (column 3, lines 50-57; column 7, line 65 to column 8, line 11; and Figure 7). Reynolds further discloses that the interactive web book system comprises a navigation tool, which allows viewers to automatically view chapters in a book sequentially, (column 10, line 64 to column 11, line 6). In addition, the navigation

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tool is disclosed to store information about ibook access requests for each client, such as corresponding date and time (column 11, lines 24-60). Therefore, it would have been obvious to incorporate the interactive book access information into the routine scheduling profile (Balma column 9, line 29-46) for implementation of the claimed limitations. One of ordinary skill in the art at the time of the invention would have been so motivated to implement these modifications so as to extend the functionality of the multi-format message system to provide literary and artistic material (e.g. essays, songs, paintings) for user enjoyment, (Reynolds column 3, lines 3-4).

In reference to claim 6, Reynolds shows the multi-format messaging system wherein the chapters of the serial novel (i.e. interactive book) are provided together with choices (i.e. derivation links) of following the chapters to be delivered (i.e. accessed), (Reynolds column 7, lines 8-22; column 8, line 61 to column 9, line 26; and Figure 7).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segur and Hayes-Roth applied to the claims above, and further in view of presto_print.com (Google Newsgroup retrieved from Internet), hereinafter referred to presto_print.com respectively.

In reference to claim 7, Segur and Hayes-Roth teach a multi-format messaging system wherein text is accompanied with the temporary name stored in the recorder (Hayes-Roth; i.e. workstation memory; Figure 5-item 12 and Figure 2-item 26). However, the references do not teach expressly each of the paragraphs comprising a

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metrical composition completed in every delivery and composed of sentences containing respective characters of the recipient's name. Nonetheless, this limitation (i.e. acrostic metrical compositions) was well known in the art at the time of the invention, as further evidenced by presto_print.com. As a result, these modifications would have been obvious to one of ordinary skill in the art at the time of the invention.

In an analogous art, presto_print.com teaches employing a telecommunications network (i.e. via Internet site, <http://www.presto-print.com>), in order to deliver a personalized message to a recipient. Presto_print.com further shows that the message employs a user specified name to form the message as a metrical compositions (i.e. acrostic poetry) containing the aforementioned name. One of ordinary skill in the art would have been motivated to automatically deliver a message using the recipient's name to form an acrostic, within the multi-format message system, in order to further increase message personalization.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur and Hayes-Roth as applied to the claims above, and further in view of Blue Mountain (Blue Mountain Arts' Electronic Greeting Cards retrieved from the Internet), hereinafter referred to as Blue Mountain.

In reference to claims 11-13, Segur and Hayes-Roth disclose a multi-format messaging system wherein paragraphs or graphic images (Figure 1, paragraph [0024], line 5 to paragraph [0025], line 25; Figure 1) contain the temporary name (e.g. recipient-name; Figure 2; paragraph [0025], line 1 to paragraph [0033], line 1). However, the

reference does not disclose expressly that the aforementioned text: comprises educational materials edited in accordance with a predetermined program [claim 11]; has a psychological content for encouragement [claim 12]; and has a formal content for congratulations or condolence [claim 13]. Nonetheless, these limitations would have been obvious modifications to the system disclosed by Segur and Hayes-Roth, as further evidenced by Blue Mountain.

In an analogous art, Blue mountain discloses electronic greeting cards that contain text to send to an intended recipient that is associated with the categories: educational material (i.e. graduation); psychological content for encouragement (i.e. follow dreams or inspiration); and formal content for congratulations or condolence (i.e. congratulations or sympathy). One of ordinary skill in the art would have been motivated to accordingly modify the multi-format system, so as to personalize and transmit electronic text messages containing content from a plurality of literary genres, thereby increasing system versatility.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on 9am-5pm.

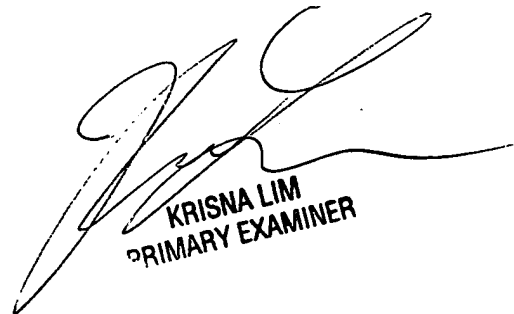
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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LaShanya Nash
Art Unit, 2153
May 13, 2005

LN


KRISNA LIM
PRIMARY EXAMINER